

SEP 13 2001



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In re Application of
BORISENKO, Dmitry *et al*
Application No.: 09/807,485
PCT No.: PCT/CA99/00928
Int. Filing Date: 13 October 1999
Priority Date: 13 October 1998
Attorney Docket No.: GOW 0082 PA
For: HIGH CAPACITANCE ENERGY
STORING DEVICE

DECISION

This decision is in response to the declaration filed on 16 July 2001 which is treated as a submission under 37 CFR 1.42.

BACKGROUND

On 12 April 2001, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an unsigned declaration.

On 14 May 2001, a Notification of Missing Requirements and Notification of a Defective Oath or Declaration was mailed indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. The declaration submitted on 18 February 2000 was not in compliance with 37 CFR 1.497(a) because it was not signed. A two-month time limit was set for response.

On 16 July 2001, applicants filed a declaration signed by co-inventor Dmitry Borisenko, a document in Russian titled "Declaration by an Administrator or Executor Attached to Patent Application" and accompanying English translation, a "Small Entity Claim and Request for Refund" and payment of \$65.00 for surcharge fees.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Here, applicants included a declaration signed by Dmitry Borisenko as a co-inventor and listing the other co-inventor, Nikolay Borisenko as deceased. The

residence and citizenship of both Dmitry Borisenko and Nikolay Borisenko are listed on the declaration pursuant to 37 CFR 1.497(a).

Applicants also included a document in Russian with accompanying English translation titled "Declaration by an Administrator or Executor Attached to Patent Application" listing Dmitry Borisenko as the legal representative of the deceased co-inventor and signed by Mr. Borisenko. This document complies with the requirements of 37 CFR 1.497(b)(2) and is notarized with an attached apostille.

However, the document does not comply with 37 CFR 1.497(a)(4) which requires that the oath or declaration states that "the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought." In the "Declaration by an Administrator or Executor Attached to Patent Application" signed on behalf of Nikolay Borisenko by Dmitry Borisenko, the declaration states "that I verily believe the said Nikolay Borisenko to be the **second inventor** of the improvement in HIGH CAPACITANCE STORAGE DEVICE described and claimed in the foregoing specification." (Emphasis added).

Request for Refund

Applicants submitted a claim for small entity status and requested a refund in the amount of \$495.00 pursuant to 37 CFR 1.28(a) which states, in part:

A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136.

In this case, the small entity statement and request for refund have been filed within three months from the payment of the filing fees. The basic national fee and a surcharge fee were paid on 12 April 2001, while the statement claiming small entity status was mailed on 11 July 2001.

CONCLUSION

For the reasons discussed above, applicants request for a refund pursuant to 37 CFR 1.28(a) is **GRANTED**. However, applicants' request Under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42".

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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